

REMARKS

Presently claims 1, 2, 4-6, 8-9, and 11-24 are pending in this application, with claims 3, 7, and 10 having been previously cancelled. The Specification is amended with this Response. Though no claims have been amended, Applicant respectfully provides the above claim listing for the Examiner's convenience. Applicant will now respectfully address the examiner's objections and rejections in turn.

Objections to the Drawings

The Examiner objects to the Drawings under 37 C.F.R. 1.83(a) for not showing every feature of the invention specified in the claims. The Examiner specifically alludes to an omission of a "structure through which coins are passed from the coin insertion (13) to the rollers (2a,2b).

Applicant notes that the relevant portion of 37 C.F.R. 1.83(a) recites, "The drawing in a non-provisional application must show every feature of the invention **specified in the claims.**" Applicant respectfully points out that the referenced "structure through which coins are passed" is *not actually specified* in the claims. As such, since such specification is a requirement of 37 C.F.R. 1.83(a), Applicant's claims and Figures are not improper under 37 C.F.R. 1.83(a). As further evidence of this, Applicant respectfully notes that the above referenced "structure" cannot be cancelled from the claims (as is a suggested remedy to the objection) as it is already absent from the claims, by virtue of the previous cancellation of claim 7.

Rejections under 35 U.S.C. 112, first paragraph

The Examiner rejects the Specification under 35 U.S.C. 112, first paragraph for alleged informalities contained specifically at Paragraph 0006. Though Applicant respectfully asserts that this 112 rejection would be more appropriately presented as an objection (because there are no claims are referred to in the rejection), Applicant respectfully responds by amending the paragraph to address the allegedly unclear description regarding the term "opposite roller." However, Applicant is respectfully

unsure what, if any, issue is being taken by the Examiner with regards to the last sentence of this rejection.

Rejections under 35 U.S.C. 103(a)

Claims 1, 2, 4-6, 9, 11, 12, and 19-24 are rejected under 103(a) as being obvious over United States Patent No. 5,355,988 to Shirasawa (“Shirasawa” hereinafter) in view of United States Patent No. 5,111,860 to Wingate-Hill (“Wingate” hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

In addition, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP 2143.01 V.

For at least the reasons set forth in *In re Gordon* and MPEP 2143.01 V, Applicant respectfully asserts that there is no motivation found in either Shirasawa or Wingate that would motivate one of ordinary skill in the art to combine these references. First of all, as is stated at column 5, lines 33-35, spikes 22 extending from the rollers 10a-10c of Wingate are necessary to locomotion or conveyance of the relevant object (log in Wingate) through the device. Thus, if Shirasawa were to be modified to include these rollers 10a-10c of Wingate (as is suggested by the Examiner), the rollers of the resulting apparatus would include the spikes 22 and cutting edges 24 taught as necessary elements in Wingate. If

Shirasawa were to include such spiked and cutting rollers, the coins running through the device would be punctured by the spikes (remember these spikes are necessary to movement via the Wingate rollers) and sliced/scraped/gouged by the cutting edges (necessary to bark removal). Coins emerging from this device would be badly deformed, and these ruined coins would not be acceptable or usable in any sort of gaming environment. Accordingly, the proposed modification would render the device of Shirasawa completely inoperable for its intended purpose of separating and supplying coins for a gaming machine.

Second, Applicant respectfully points out that if Wingate were to be modified to separate logs via inclusion of the coin separating elements taught Shirasawa (i.e. the roller configuration and conveyer belt), then at least two logs would have to at some point make simultaneously contact with one of the Wingate rollers (as is shown with two coins in Figures 5 and 7 of Shirasawa). This simultaneous contact would result in at least one of the logs coming into contact with a roller. Such contact would have at least two undesirable effects if it were to occur in Wingate. First, since the bark of a log is disposed at its radial periphery, end contact with the log would result in contact between the pulp/wood (i.e. the interior) of the log and the spikes 22 and cutting edges 24 of the rollers 10a-10c. Obviously, a bark removing apparatus that is modified in manner that causes removal of considerable portions of log interior would become inoperable for its intended purpose. Furthermore, due to the size (and forces created by this size) of the logs being moved, direct contact between the ends of logs and the rollers 10a-c could result in both damage to, and jamming of, the apparatus taught in Wingate. Accordingly, the proposed modification would render the device of Wingate inoperable for its intended purpose of debarking logs.

The above inoperabilities are so prevalent and obvious because the technical fields of the two references are so very different. Such differences clearly demonstrate a lack of motivation to combine. Not only is there an obvious difference in the size and shape of the respective objects to be conveyed (i.e. coins and logs), which leads to differences in mechanism of the rollers (rod-like logs can be, and are, moved via very different rolling

mechanisms than disc shaped coins), but the purpose of the respective rollers are also very different. The rollers of Shirasawa are configured to *separate* coins. The rollers of Wingate are configured to remove bark from *already separated* logs. Thus, since the conveyed objects of the references are very different, and since the roller purpose and configuration in the references are in no way related (the logs of Wingate are in no way taught to be separated by the rollers of Wingate, and the coins of Shirasawa are in no way taught to be debarked by the rollers taught in Shirasawa), there is clearly no motivation found in either reference that motivate one of ordinary skill in the art to combine Shirasawa with Wingate.

Claims 8, 13, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa in view of Wingate and United States Patent No. 5,988,349 to Bruner (“Bruner” hereinafter). Applicant respectfully traverses, with claim 7 having been respectfully cancelled.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As Bruner does not remedy the deficiencies of Shirasawa, and claims 8, 13, and 18 depend variously from claims 1 and 9, the proposed combination of Shirasawa and Bruner, without Wingate, does not teach every element of claims 8, 13, and 18. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 8, 13, and 19 with respect to the proposed combination of Shirasawa and Bruner.

Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa in view of Wingate and United States Patent No. 5,713,451 to Masse (“Masse” hereinafter). Applicant respectfully traverses.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As Bruner does not remedy the deficiencies of Shirasawa, and claims 14, 16, and 17 depend from

claim 9, the proposed combination of Shirasawa and Masse, without Wingate, does not teach every element of claims 14, 16, and 17. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 14, 16, and 17 with respect to the proposed combination of Shirasawa and Masse.

Claim 15 is rejected under 35 U.S.C. 103(a) as being obvious over Shirasawa, in view of Masse, Wingate, and United States Publication No. 2003/0127299 to Jones (“Jones” hereinafter). Applicant respectfully traverses.

With reference to the arguments above, Applicant respectfully points out that there is no motivation to combine Shirasawa and Wingate. As neither Masse nor Jones remedies the deficiencies of Shirasawa, and claim 15 depends from claim 9, the proposed combination of Shirasawa, Masse, and Jones, without Wingate, does not teach every element of claim 15. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 15 with respect to the proposed combination of Shirasawa, Masse, and Jones.

Conclusion

All of the objections and rejections are herein overcome. In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. No new matter is added by way of the present Amendments and Remarks, as support is found throughout the original filed specification, claims and drawings. Prompt issuance of Notice of Allowance is respectfully requested.

The Examiner is invited to contact Applicant's attorney at the below listed phone number regarding this response or otherwise concerning the present application.

Applicant hereby petitions for any extension of time under 37 C.F.R. 1.136(a) or 1.136(b) that may be necessary for entry and consideration of the present Reply.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorneys.

Respectfully submitted,

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